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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,929	06/07/2000	Larry Dolinar	NORT0032(11795RRUS02U)	1225

7590

03/26/2004

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EXAMINER

CALDWELL, ANDREW T

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 03/26/2004

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/588,929

Applicant(s)

DOLINAR ET AL.

Examiner

Andrew Caldwell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 24-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Remarks

Claims 1-22 and 24-38 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-5, 7, 9, 11, 13-15, 17-18, 21-22, 24-25, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Alcatel USA Sourcing, L.P., WO 99/20058, and Newton, H., Newton's Telecom Dictionary, Telecom Books, pp. 684-685, 1998.

Regarding claim 11, Alcatel anticipates the claimed invention by disclosing a system comprising:

A software module containing instructions specifying performance of telephony services in the communication network (Fig. 6 elem. 30; p. 21 lines 11-30);

An interface layer comprising one or more components responsive to execution of the software module to provide commands over a packet-based network to corresponding network elements to perform the telephony services specified by the software module (Fig. 6 elem. 12 service management system;

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1 p. 16 lines 10-23; p. 12 lines 15-28; p. 27 lines 17-30; where the service
2 management system communicates with the SCP's using SS7).

3 Newton is cited to provide evidence that an SS7 signaling messages are sent
4 over a packet-based network (p. 684 bottom of col. 1).

5
6 Regarding claim 13, Alcatel teaches a system wherein the interface layer
7 comprises a communications component to send the commands to the network
8 elements (p. 16 lines 10-23; p. 28 line 32 to p. 29 line 16; p. 29 line 26 to p. 30 line 33
9 provisioning and application logic).

10 Regarding claim 14, Alcatel teaches a system wherein the communications
11 component comprises an Object Request Broker (p. 12 lines 25-28; p. 29 lines 4-6).

12 Regarding claim 15, Alcatel teaches a system wherein the communications
13 component comprises an application programming interface (p. 30 lines 31-33).

14 Regarding claim 17, Alcatel teaches a system wherein the software module
15 comprises a script (p. 26 lines 5-10 service script).

16 Regarding claim 18, Alcatel teaches a system wherein the interface layer
17 comprises a script engine (p. 26 lines 5-10 service script).

18 Regarding claim 21, Alcatel teaches a system wherein the interface layer
19 comprises a Common Object Request Broker Architecture component (p. 12 lines 25-
20 28; p. 29 lines 4-6).

21 Regarding claims 1, 3-5, and 7, they are method claims corresponding to
22 apparatus claims 11, 15, 17-18, and 21. Since they do not teach or define above the

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1 information in the corresponding apparatus claims, they are rejected under the same
2 basis. The claims correspond as follows: 1 with 11; 3 with 17; 4 with 18; 5 with 15 and
3 18; 7 with 21.

4 Regarding claim 9, Alcatel teaches a method further comprising the software
5 module receiving user input from which is generated the requests (; p. 21 lines 11-30).

6 Regarding claim 22, it is an apparatus claim written in means plus function form
7 corresponding to apparatus claim 11, which is written using structural elements. Since
8 the structural elements of claim 11 correspond to the means recited in claim 22, no
9 separate reasons for rejection are necessary.

10 Regarding claim 24-25, they are computer readable media claims corresponding
11 to apparatus claim 11 and 21, respectively. Since it does not teach or define above the
12 information in the corresponding apparatus claims, they are rejected under the same
13 basis.

14 Regarding claim 27, it is a "carrier wave" claim corresponding to method claim 1.
15 Since it does not teach or define above the information in the corresponding method
16 claim, it is rejected under the same basis.

17
18 ***Claim Rejections - 35 USC § 103***

19 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
20 obviousness rejections set forth in this Office action:

21 (a) A patent may not be obtained though the invention is not identically disclosed or described as set
22 forth in section 102 of this title, if the differences between the subject matter sought to be patented and
23 the prior art are such that the subject matter as a whole would have been obvious at the time the
24 invention was made to a person having ordinary skill in the art to which said subject matter pertains.
25 Patentability shall not be negated by the manner in which the invention was made.

1
2 This application currently names joint inventors. In considering patentability of
3 the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of
4 the various claims was commonly owned at the time any inventions covered therein
5 were made absent any evidence to the contrary. Applicant is advised of the obligation
6 under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was
7 not commonly owned at the time a later invention was made in order for the examiner to
8 consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)
9 prior art under 35 U.S.C. 103(a).

10
11 Claims 1-5, 8-13, 15-19, 22, and 24-38 are rejected under 35 U.S.C. 103(a) as
12 being unpatentable over Lennox, Call Processing Language Framework and
13 Requirements, IETF Internet Draft, draft-ietf-iptel-cpl-framework-00.ps, pp. 1-15, June
14 25, 1999 (hereinafter Lennox I), in view of Brewster et al., U.S. Patent No. 5,870,464.
15 Apparatus claims 11-21 and 31-34 will be discussed before their corresponding method,
16 media, or carrier wave claims.

17
18 Regarding claim 11, Lennox I teaches the invention substantially as claimed by
19 disclosing an apparatus comprising a software module containing instructions specifying
20 performance of telephony services in the communications network (p. 5 § 3.3 CPL
21 scripts as software modules) and a CPL server that executes the script and provides
22 commands over a packet based network to corresponding network elements to perform
23 the telephony services specified by the software module (pp. 7-8 § 3.3.6 CPL server to

1 server interactions as commands over a packet based network to perform telephony
2 services).

3 Lennox I does not specifically teach an interface layer comprising one or more
4 components responsive to execution of the software module (i.e., CPL script). More
5 specifically, Lennox I does not teach an interface layer/script engine (see claim 18) for
6 executing the CPL scripts.

7 Brewster on the other hand teaches an apparatus further comprising
8 providing at least one scripting engine capable of accessing scripting modules and
9 wherein scripting modules are executed by the at least one scripting engine (Fig. 2
10 elem. 65).

11 It would have been obvious to one of ordinary skill in the art at the time the
12 invention was made to combine Brewster's teachings regarding the use of scripting
13 engines to execute scripts with the system of Lennox I by including a scripting engine to
14 execute Lennox I's scripts. This combination would have been obvious based on logical
15 reasoning from the teachings of Lennox I since a person of ordinary skill in the art at the
16 time the invention was made would reasonably infer that a system executing scripts,
17 such as the one in Lennox I, would have a scripting engine that enables their execution.

18 Regarding claim 12, Lennox I teaches an apparatus wherein the interface layer
19 comprises representations of the network elements (p. 3 motivating examples).

20 Regarding claim 13, Lennox I teaches an apparatus wherein the interface layer
21 comprises a communications component to send the commands to the network
22 elements (pp. 7-8 § 3.6.3 server-to-server interactions; pp. 10-11 call signaling).

1 Regarding claim 15, Lennox I teaches an apparatus wherein the communications
2 component comprises an application programming interface (p. 9 SIP CGI).

3 Regarding claim 16, Lennox I teaches a apparatus wherein the commands
4 include SIP messages (p. 10 underlying signaling details).

5 Regarding claim 17, Lennox I teaches an apparatus wherein the software module
6 comprises a script (p. 5 § 3.3 CPL scripts as software modules).

7 Regarding claim 18, Brewster teaches an apparatus wherein the interface layer
8 comprises a script engine (Fig. 2 elem. 65).

9 Regarding claim 19, Lennox I teaches an apparatus wherein the software module
10 comprises a Java object (p. 8 § 3.7 Relationship with existing languages).

11 Regarding claim 31, Lennox I teaches an apparatus wherein the representations
12 of the network element comprise a representation of a voice mail system (p. 3).

13 Regarding claim 32, Lennox I teaches an apparatus wherein sending commands
14 over the packet-based network comprises sending the commands over an IP network
15 (p. 3 Architecture).

16 Regarding claims 33 and 34, Lennox I teaches an apparatus wherein the
17 software module contains instructions specifying performance of telephony services
18 over the packet-based network (pp. 1-15).

19 Regarding claims 1-5, 8, 10, and 28-30, they are method claims corresponding to
20 apparatus claims 11-13, 15-19 and 31-34. Since they do not teach or define above the
21 information in the corresponding apparatus claims, they are rejected under the same
22 basis.

1 Regarding claim 9, Lennox I teaches a method further comprising the software
2 module receiving user input from which is generated the requests (p. 6 § 3.4 script
3 creation and transport).

4 Regarding claim 22, it is an apparatus claim written in means plus function form
5 corresponding to apparatus claim 11, which is written using structural elements. Since
6 the structural elements of claim 11 correspond to the means recited in claim 22, no
7 separate reasons for rejection are necessary.

8 Regarding claim 24-25 and 36-38, they are computer readable media claims
9 corresponding to apparatus claim 11, 21, and 31-33, respectively. Since it does not
10 teach or define above the information in the corresponding apparatus claims, they are
11 rejected under the same basis.

12 Regarding claim 26, Lennox I teaches an article wherein the instructions when
13 executed cause the controller to perform accessing voice mail (p. 3).

14 Regarding claim 27, it is a "carrier wave" claim corresponding to method claim 1.
15 Since it does not teach or define above the information in the corresponding method
16 claim, it is rejected under the same basis.

17 Regarding claim 35, it is an apparatus claim written in means plus function form
18 corresponding to apparatus claims 12 and 34, which is written using structural
19 elements. Since the structural elements of claim 11 correspond to the means recited in
20 claims 22 and 34, no separate reasons for rejection are necessary.

21

1 Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alcatel
2 in view of Gralla, P., How the Internet Works, special ed., Ziff-Davis Press, pp. 184-187,
3 1997.

4
5 Regarding claim 19, Alcatel teaches the invention substantially as claimed. See
6 the rejection of claim 11 above. Alcatel does not explicitly teach a system wherein the
7 software module comprises a Java object. Alcatel does however teach that the
8 software module/service management access point includes a web server (Fig. 6 elem.
9 30) and that the user interface is implemented within a Netscape browser (Figs. 8A &
10 8B). Figures 8A and 8B show functions implemented within the web page window such
11 as menus (file, edit, view, special, help), buttons (Fig. 8b "click a button), and the
12 dragging of service features onto the service program (Fig. 8A). Upon considering
13 these features, a person of ordinary skill in the art at the time the invention was made
14 would conclude that these functions are not performed by a simple HTML web page.
15 Particularly the dragging feature suggests something more complicated. Gralla teaches
16 that Java applets are object oriented programs (p. 185 second paragraph indicating that
17 Java is an object-oriented language). Gralla teaches that applets are used to
18 implement user interactive features of web pages (p. 187 step 6). It would have been
19 obvious to one of ordinary skill in the art at the time the invention was made to
20 implement the user interface features of the web pages of Figures 8A and 8B using
21 Java applets because Java applets are platform independent (Gralla p. 185 third
22 paragraph). Once these features are implemented using Java applets, the service

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1 management access point must store these applets so they can be served to particular
2 browsers. Accordingly, Alcatel teaches a system wherein the software module
3 comprises a Java object.

5 ***Double Patenting***

6 The nonstatutory double patenting rejection is based on a judicially created
7 doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the
8 unjustified or improper timewise extension of the "right to exclude" granted by a patent
9 and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11
10 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225
11 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA
12 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*,
13 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

14 A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be
15 used to overcome an actual or provisional rejection based on a nonstatutory double
16 patenting ground provided the conflicting application or patent is shown to be commonly
17 owned with this application. See 37 CFR 1.130(b).

18 Effective January 1, 1994, a registered attorney or agent of record may sign a
19 terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with
20 37 CFR 3.73(b).

21
22 Claims 1-38 are rejected under the judicially created doctrine of obviousness-
23 type double patenting as being unpatentable over claims 1-30 of U.S. Patent No.
24 6,701,366. Although the conflicting claims are not identical, they are not patentably
25 distinct from each other because the narrower claims of '366 patent render the broader
26 claims of this application obvious based on the legal precedent that omission of an
27 element and its function is obvious if the function of the element. *Ex parte Wu*, 10
28 USPQ 2031 (Bd. Pat. App. & Inter. 1989).

30 ***Response to Arguments***

1 As to the rejection of claims 1, 3-5, 7, 9, 11, 13-15, 17-18, 21-22, 24-25, and 27
2 under 35 U.S.C. 102(b) as being anticipated by Alcatel, the Applicants' arguments filed
3 on December 29, 2003 (paper no. 5) have been fully considered but they are not
4 persuasive. The Applicants are arguing that Alcatel fails to teach the interface layer that
5 provides commands over a packet based network to corresponding network elements.
6 As the Applicants point out on the first paragraph of page 9 of the response, the service
7 management system, service control points, and signal transfer points of Alcatel reside
8 in an SS7 network. An inherent characteristic of SS7 is that the signaling messages are
9 transferred over a packet-based network. Evidence of this inherent feature is provided
10 by Newton. Alcatel and Newton therefore teach the limitation at issue, and the
11 Applicants' argument is not deemed persuasive.

12 As to the rejection of claims 1-4, 8, 10-13, and 22-27 under 35 U.S.C. 102(e) as
13 being anticipated by Wolf, the Applicants' arguments filed on December 29, 2003 (paper
14 no. 5) have been fully considered and are deemed persuasive. The rejection has
15 therefore been withdrawn.

16 As to the rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable
17 over Wolf, the rejection has been withdrawn for the reason given above with respect to
18 claims 1-4, 8, 10-13, and 22-27.

19 As to the rejection of claim 19 under 35 U.S.C. 103(a) as being unpatentable
20 over Alcatel, the Applicants have challenged the Examiner's taking of official notice
21 regarding basic features of Java applets. The Examiner has therefore provided

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1 excerpts from a basic networking reference to provide evidence that the features for
2 which official notice was taken are actually known in the art.

3 As to the rejection of claims 6 and 20 are rejected under 35 U.S.C. 103(a) as
4 being unpatentable over Alcatel in view of Box, the Applicants' arguments filed on
5 December 29, 2003 (paper no. 5) have been fully considered and are deemed
6 persuasive. The rejection has therefore been withdrawn.

8 **Conclusion**

9 Applicant's amendment necessitated the new ground(s) of rejection presented in
10 this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP
11 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
12 CFR 1.136(a).

13
14 A shortened statutory period for reply to this final action is set to expire THREE
15 MONTHS from the mailing date of this action. In the event a first reply is filed within
16 TWO MONTHS of the mailing date of this final action and the advisory action is not
17 mailed until after the end of the THREE-MONTH shortened statutory period, then the
18 shortened statutory period will expire on the date the advisory action is mailed, and any
19 extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of
20 the advisory action. In no event, however, will the statutory period for reply expire later
21 than SIX MONTHS from the date of this final action.

22
23 Any inquiry concerning this communication or earlier communications from the
24 examiner should be directed to Andrew Caldwell, whose telephone number is (703)
25 306-3036. The examiner can normally be reached on M-F from 9:00 a.m. to 5:30 p.m.
26 EST.

27
28 If attempts to reach the examiner by phone fail, the examiner's supervisor,
29 Glenton Burgess, can be reached at (703) 305-4792. Additionally, the fax numbers for
30 Group 2100 are as follows:

31
32 Fax Responses: (703) 872-9306
33
34
35

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at (703) 305-9600.

A handwritten signature in black ink that reads "Andrew Caldwell". The signature is written in a cursive style with a large, stylized "Q" at the end.

Andrew Caldwell

703-306-3036

March 19, 2004